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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN FRED DAVIS, KEVIN DAVID HIMBERGER,
CLARK DEBS JEFFRIES, and GARRETH JOSEPH JEREMIAH

Appeal 2010-000189
Application 10/796,161¹
Technology Center 2400

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
JAMES R. HUGHES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 41.52, Appellants have filed a Request for Rehearing alleging a misapprehension or oversight by this Board in a Decision on Appeal mailed March 29, 2012. In that Decision the Board affirmed the Examiner's rejection of claims 1-16 and 21-28.

¹ Application filed March 9, 2004. The real party in interest is International Business Machines Corp. (Br. 1.)

ANALYSIS

In a Request for Rehearing received April 18, 2012, Appellants contend that:

1. . . . [T]he Board overlooked a key element of claim 1 which states that **in response to** querying an entity that manages registration of IP addresses to determine other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail, subsequent e-mails **from the other IP addresses** are blocked. The Board overlooked this recitation in claim 1 that these other source IP addresses of the spammer are blocked based on their registration by the spammer irrespective of whether spam was sent from these other source IP addresses[; and]

2. The Board cited as a reason to affirm the rejection that Appellant did not file a Reply Brief.

(Req. Reh'g. 3.)²

We have carefully reviewed the Decision in light of Appellants' allegation of error. We find Appellants contentions to be without merit and we decline to make any substantive change to our Decision.

With respect to Appellants' first point of error, the Board did not overlook the described element. (Req. Reh'g. 2, 3-4.) As we indicated in the Decision, "[w]e broadly but reasonably construe" (Dec. 7) "an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant" (claim 1) "to be an Internet web site or service that performs the claimed functionality of allowing one to determine IP addresses registered to a registrant or vice versa." (Dec. 7.) Accordingly,

² We refer to Appellants' Appeal Brief ("Br.") filed March 23, 2009 and Request for Rehearing ("Req. Reh'g.") filed April 18, 2012. We also refer to our Decision on Appeal ("Dec.") mailed March 29, 2012.

we found Spamhaus would have taught or at least suggested such an entity. (Dec. 7.) We also agreed with the Examiner’s finding that Kirsch describes determining a source IP address of the unwanted e-mail and filtering (blocking) the unwanted e-mail (Dec. 5-6) – in other words blocking email based on a source IP address. Thus we concluded “that the combination of Kirsch and Spamhaus would have taught or fairly suggested the disputed features of representative claim 1” (Dec. 7) – that is, “querying an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant of the source IP address of said unwanted e-mail, and in response, blocking subsequent e-mails from said other IP addresses” (claim 1). Put another way, the combination of Kirsch and Spamhaus would have taught or fairly suggested blocking subsequent e-mails – as taught by Kirsch – from other IP addresses (other source IP addresses registered to said registrant of the source IP address) – as taught by Spamhaus. The blocking is responsive to the query as discussed *supra*. (See Req. Reh’g. 3-4.)

Appellant also presents supplemental arguments in the Request for Rehearing concerning claim 1 (Req. Reh’g. 2, 3-4) – “that these other source IP addresses of the spammer are blocked based on their registration by the spammer *irrespective of whether spam was sent from these other source IP addresses*” (Req. Reh’g. 4). Such arguments at this stage of the prosecution are inappropriate and will not be considered. 37 C.F.R. § 41.52 (a)(1). Further, this argument is not commensurate with the scope of Appellants’ claim – there is no recitation limiting the “other IP addresses.” The claim simply requires that other IP addresses (i.e., additional IP addresses

associated with (registered to) the registrant of the source IP address) be identified and utilized to block e-mail.

With respect to Appellants' second point of error, the Board did not misapprehend the optional nature of filing a Reply Brief. (Req. Reh'g. 3, 4.) The Board did not state that Appellants omitted an affirmative requirement in failing to file a Reply Brief. Rather, the Board pointed out that in failing to file a Reply Brief Appellants' failed to rebut the findings and responsive arguments made by the Examiner in the Answer. (Dec. 8.) It follows that the preponderance of the evidence in the record supported the Examiner's findings and conclusions.

CONCLUSION

In view of the foregoing discussion, we deny Appellants' request for rehearing. We decline to modify our original Decision.

REQUEST FOR REHEARING – DENIED